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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,924	11/17/2003	Richard York	100202701-1	4218

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,924

Applicant(s)

YORK, RICHARD

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 11 are rejected under 35 U.S.C. 112, 2nd paragraph as the claim scopes are uncertain since the trademarks or trade names cannot be used properly to identify any particular material. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. The term, "Checkpoint" in claim 9 is taken to mean software for customer data verification and the term "Search America" in claim 11 is also taken to mean software for customer data verification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 12, 16-21, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence (U.S. Patent Application Publication No. 2002/0138371).

Referring to claim 1. Lawrence discloses a method of verifying orders for fraud prevention comprising:

- Assigning a risk factor with an incoming order (Lawrence: abstract); and
- Providing a set of information to verify based upon the risk factor assigned to the incoming order (Lawrence: paragraph 23).

Referring to claim 2. Lawrence further discloses a method wherein an incoming order may be associated with one of the risk factor of low risk, medium risk, or high risk (Lawrence: paragraph 24).

Referring to claim 3. Lawrence further discloses a method comprising prior to assigning the risk factor to the incoming order, outsourcing the incoming order into an outsort queue (Lawrence: paragraphs 24 & 30). The examiner notes that Lawrence discloses the risk management system receiving information from transactions placed in a marketplace in the order in which they are received, a method of sorting into a queue.

Referring to claims 4-6. Lawrence further discloses a method comprising verifying the set information to permit fraud investigation process that requires a lower, increased, or higher amount of resources and time, if the incoming order has been associated with a risk factor of low, medium, or high risk, respectively (Lawrence: paragraphs 12 & 23).

Referring to claim 12. Lawrence further discloses a method wherein the order is received in a website (Lawrence: abstract & paragraph 59).

Referring to claims 16-21 & 25-26. Claims 16-21 & 25-26 are rejected under the same rationale set forth above. Lawrence discloses an apparatus and computer readable medium for performing the above methods (Lawrence: paragraph 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-11, 13-15, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence (U.S. Patent Application Publication No. 2002/0138371) in view of Kawecky (U.S. Patent No. 5,963,625).

Referring to claim 7. Lawrence further discloses a method wherein the action of verifying the set of information comprises:

- Reviewing an order history for a customer (Lawrence: paragraph 15);
- Reviewing an internet protocol address for the order, if the order is received from the internet (Lawrence: paragraph 39);
- If the internet protocol address is from a vendor that will respond to the order, then searching for a name of the customer in a directory of the vendor (Lawrence: paragraph 40);

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- Lawrence discloses all of the above but does not expressly disclose performing an auto-number identification search. Kawecki discloses a method of verifying information by performing an auto-number identification search (Kawecki: abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Lawrence to have included performing an auto-number identification search, as taught by Kawecki, in order to block undesirable transactions (Kawecki: abstract).
- Accepting the order if the set of information is verified (Lawrence: paragraph 9).

Referring to claim 8. The combination and Lawrence and Kawecki discloses all of the above and further discloses a method of verifying a set of information comprising:

- Searching for a billing or shipping name, address, auto-number identification number, or phone number in a search tool (Kawecki: column 2, lines 19-41 & column 8, lines 4-19);
- Searching the shipping address in an address search tool that can verify information about addresses (Kawecki: column 8, lines 4-19);
- Calling a phone number for a bank, if the phone number is available (Kawecki: column 10, lines 53-64). The examiner notes that Kawecki discloses querying a credit card company to verify information.
- Accepting the order if the set of information is verified (Lawrence: paragraph 9).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Lawrence to have searched for billing or

shipping names, addresses, and phone numbers, as taught by Kaweck, to further prevent fraudulent transactions (Kaweck: abstract).

Referring to claim 9. Lawrence further discloses a method wherein the search tool is customer data verification software (Lawrence: abstract).

Referring to claim 10. The combination and Lawrence and Kaweck discloses all of the above and further discloses a method of verifying a set of information comprising:

- Searching the billing name and address and auto-number identification number in a second search tool (Kaweck: column 7, lines 17-36);
- Permitting an employee of the company to verify customer information with the bank or the customer to confirm the order (Kaweck: column 8, lines 37-56); and
- Accepting the order if the set of information is verified (Lawrence: paragraph 9).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Lawrence to have searched for billing or shipping names, addresses, and phone numbers in a second search tool or contact the bank or customer directly, as taught by Kaweck, to further prevent fraudulent transactions (Kaweck: abstract).

Referring to claim 11. Lawrence further discloses a method wherein the search tool is customer data verification software (Lawrence: abstract).

Referring to claim 13. Claim 13 is rejected under the same rationale set forth above.

Referring to claims 14-15. Lawrence discloses all of the above as noted under the 102 (b) rejection, but does not expressly disclose a method wherein the order is an

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order for a product or a service. Kawecki discloses a method wherein the order is an order for a product or a service (Kawecki: abstract & column 7, lines 51-57). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Lawrence wherein the order is an order for a product or a service, as taught by Kawecki, as they common reasons for online transactions (Kawecki: abstract & column 7, lines 51-57).

Referring to claims 22-24. Claims 22-24 are rejected under the same rationale set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mandler (U.S. Patent No. 5,732,400) discloses a system and method for risk-based purchase of goods in an on-line transaction.
- Takami (U.S. Patent Application Publication No. 2001/0032180) discloses a system and method for carrying out a transaction with high security.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

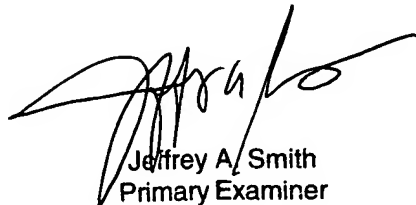
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD
Patent Examiner
01/06/06



Handwritten signature and date 1/6/06.



Handwritten signature of Jeffrey A. Smith.

Jeffrey A. Smith
Primary Examiner